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FACSIMILE SUBMISSION UNDER 37 CFR 1.8

TO:	FROM:
Examiner - Ilwoo Park	Daniel T. Lund
COMPANY:	DATE:
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RE:	APPLICATION SERIAL NUMBER:
Petition to Rescind Finality of the Office Action	09/938,144

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PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert B. Wood Confirmation No. 1721
Serial No.: 09/938,144
Filed: August 23, 2001 Customer No.: 28863
Examiner: Ilwoo Park
Group Art Unit: 2182
Docket No.: 1081-037US01/STL9833
Title: INTELLIGENT DATA STORAGE DEVICE

CERTIFICATE UNDER 37 CFR 1.8 I hereby certify that this correspondence is being transmitted via facsimile to the United States Patent and Trademark Office on December 11, 2006.

By: 

Name: Patricia Cygan

PETITION TO RESCIND FINALITY OF THE OFFICE ACTION

Mail Stop: Petitions
Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions the Director of the USPTO to rescind the finality of the Final Office Action mailed September 11, 2006 under CFR §1.181. Applicant objects to the finality of the Office Action dated September 11, 2006 as being premature.

Applicant submitted a Petition to Rescind the Finality of the Office Action on November 13, 2006 invoking the supervisory authority of the Director of the USPTO under CFR §1.181. However, this petition was not reviewed by the Technology Center Director as specified by MPEP 1002.02(c), but was responded to by the Examiner via an advisory action dated November 20, 2006. In a subsequent discussion with Kim Huynh, Applicant's representative was informed that the advisory action dated November 20, 2006 was proper procedure given that CFR §1.181(c) states that, "may be required that there have been a proper request for

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reconsideration [CFR § 1.111] and a repeated action by the examiner." However, Applicant disagrees that the Petition to Rescind the Finality of the Office Action dated November 13, 2006 should properly have been reviewed by the Examiner because MPEP 1002.02(c) dictates that such a petition is to be decided by the Technology Center Director. While CFR §1.181(c) is permissive, i.e., "it may be required . . .," MPEP 1002.02(c) is explicit in requiring that such a petition is to be decided by the Technology Center Director.

Nonetheless, Applicant hereby submits this Petition to Rescind the Finality of the Office Action to appeal the advisory action dated November 20, 2006, which upheld the finality of the Office Action dated September 11, 2006. Under any interpretation of CFR §1.181 and MPEP 1002.02(c), the presently filed the Petition to Rescind the Finality of the Office Action is to be decided by the Technology Center Director.

Applicant submits the following remarks in support of this petition:

I. A Final Office Action providing a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement is not proper.

The relevant rule regarding the finality of Office Actions is set out in MPEP 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicant discussed the finality of Office Action dated September 11, 2006 first with the Examiner, Ilwoo Park and later with his supervisor, Kim Huynh on Monday November 13, 2006. Applicant argued that because the amendment submitted June 29, 2006 did not further limit the scope of claims 1 and 18 in any way, that the amendment could not have necessitated the new grounds of rejection of claims 1 and 18 as required for a proper Final Office Action. Kim Huynh disagreed with Applicant's understanding of the MPEP and indicated that because the scope of claims 1 and 18 had changed, the Office Action dated September 11, 2006 was properly final. Applicant finds no support in the MPEP or elsewhere for the proposition that an amendment that only broadens the scope of a claim can necessitate a new ground of rejection. Applicant

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respectfully submits that such a proposition is directly contrary to the clear meaning of the relevant rule regarding the finality of Office Actions as set out in MPEP 706.07(a).

II. The new grounds of rejection was not based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).

Applicant did not submit an information disclosure statement filed during the period set forth in 37 CFR 1.97(c); therefore, an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) did not necessitate the new grounds of rejection.

III. The Examiner provided a new grounds of rejection necessitated by an error in the Office Action dated March 1, 2006 and not by Applicant's amendment of the claims.

The Examiner failed to provide a *prima facie* case of obviousness with respect to claims 1 and 18 in the Office Action dated March 1, 2006. Specifically, in the Office Action dated March 1, 2006, the Examiner rejected claims 1 and 18 under 35 U.S.C. § 103(a) as obvious over Hacker, *MP3: The Definitive Guide*, published March 2000 (hereinafter "Hacker") in view of Bruner et al. (USPN 6,212,588). In Applicant's amendment submitted June 29, 2006, Applicant pointed out the Examiner's error in failing to provide a *prima facie* case of obviousness of claims 1 and 18 using Hacker in view of Bruner et al.

The Examiner provided a new grounds of rejection in the Final Office Action dated September 11, 2006. Specifically, the Examiner rejected claims 1 and 18 under 35 U.S.C. 102(b) as being anticipated by Stefanksky (US 6,226,143). By rejecting claims 1 and 18 under a new grounds of rejection, the Examiner implicitly agreed with Applicant in that the Examinee did not provide a *prima facie* case of obviousness of claims 1 and 18 in the Office Action dated March 1, 2006.

In Applicant's amendment submitted June 29, 2006, Applicant amended claims 1 and 18 by deleting features not necessary to distinguish the Applicant's invention as recited claims 1 and 18 over the prior art of record at that time. Importantly, Applicant did not add any of the features recited in claims 1 and 18 in the amendment submitted June 29, 2006. For example, Applicant amended claim 1 as shown below:

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Claim 1 (Currently Amended): ~~A data storage device in a form factor assembly not greater than three and one half inches comprising:~~
a data disc rotatably mounted on a baseplate;
~~an actuator arm adjacent to the data disc carrying a transducer for reading data from and writing data to the data disc;~~
a printed circuit board (PCB) fastened to the baseplate having a servo controller ~~in operable communication with the actuator arm for moving the actuator arm over the data disc; and~~
a central processing unit (CPU) mounted to the PCB ~~generating control signals to the servo controller and running an operating system; and~~
~~memory storing an application program operably connected to the CPU, whereby the application program is run by the CPU.~~

Because Applicant did not add any features in claim 1 or claim 18, it is clear that Applicant's amendments only broadened the subject matter of claims 1 and 18. If the rejection under 35 U.S.C. § 103(a) as being obvious over Hacker in view of Bruner et al. of claims 1 and 18 prior to the broadening amendment had properly supported the rejection, the same grounds of rejection would have also supported a rejection of claims 1 and 18 as broadened after the amendment. For this reason, Applicant's amendment submitted June 29, 2006 could not have necessitated the new grounds of rejection in set for the in the Final Office Action with respect to at least claims 1 and 18.

IV. Conclusion

In the Office Action dated September 11, 2006, the Examiner introduced a new ground of rejection not necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). For this reason, the Office Action dated September 11, 2006 properly should be designated as non-final. Applicant respectfully requests the Director rescind the finality of the Office Action dated September 11, 2006.

No fee is believed due at this time. If any fee is required for consideration of this petition, please charge deposit account number 50-1778 the amount required for consideration of this petition. Please charge any additional fees or credit any overpayment to deposit account number 50-1778.

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Date:

By:

December 11, 2006

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